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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/784,385	02/23/2004	Daniel Seguin	MOSA-09	8425

26875 7590 02/07/2007  
WOOD, HERRON & EVANS, LLP  
2700 CAREW TOWER  
441 VINE STREET  
CINCINNATI, OH 45202

EXAMINER
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DUNWOODY, AARON M

ART UNIT	PAPER NUMBER
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3679

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/07/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/784,385	<b>Applicant(s)</b> SEGUIN ET AL.	
	<b>Examiner</b> Aaron M. Dunwoody	<b>Art Unit</b> 3679	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 10 January 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) 6-11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                        | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION*****Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/11/2006 has been entered.

***Claim Rejections - 35 USC § 112***

Claims 1-5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

There is an inconsistency between the language in the preamble and certain portions in the body of the claim, thereby making the scope of the claim unclear. The preamble in claim clearly indicates that a subcombination is being claimed, e.g., "a mounting for connecting pipettes." This language would lead the examiner to believe that the applicant intends to claim only the subcombination of "a mounting" and the pipettes being only functionally recited. This presents no problem as long as the body of the claim also refers to the functionally, such as, "for attachment to said pipettes."

The problem arises when the pipettes are positively recited within the body of the claim, such as, "the pipettes extending through a distal end of the stabilizing member." There is an inconsistency within the claim; the preamble indicates subcombination,

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while in at least one instance in the body of the claim there is a positive recital of structure indicating that the combination of a mounting and pipettes are being claimed. The examiner cannot be sure if applicant's intent is to claim merely the mounting or the mounting in combination with the pipettes.

Applicant is required to clarify what the claims are intended to be drawn to, i.e., either the mounting alone or the combination of the mounting and the pipettes.

Applicant should make the language of the claim consistent with applicant's intent. In formulating a rejection on the merits, the examiner is considering that the claims are drawn to the subcombination and the claims will be rejected accordingly. If applicant indicates by amendment that the combination claim is the intention, the language in the preamble should be made consistent with the language in the body of the claims. If the intent is to claim the subcombination, then the body of the claims must be amended to remove positive recitation of the combination.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over US patent 4257268, Pepicelli et al in view of US patent 6117394, Smith.

In regards to claim 1, Pipicelli et al disclose a mounting fixture for connecting pipettes of various sizes to the air channel of a pipettor, the fixture comprising a tubular

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nose (240) having a proximate end secured to the pipettor and an open distal end; and a resilient retainer (242) lining the interior of the nose, the retainer having an axial passageway communicating at its entry and exit openings respectively with the open distal end of the nose and with the air channel of the pipettor, the passageway being tapered from a maximum diameter at the entry opening to a minimum diameter at the exit opening, the entry opening being sized to axially receive the largest of the pipettes and the sleeve being internally configured to resiliently grip differently sized pipettes inserted therein at different locations along the length thereof. Pepicelli does not disclose a stabilizing member at the open distal end of the nose. Smith teaches a stabilizing member (Tp) at the open distal end of the nose (P) to limit the possibility of cross contamination between samples (col. 1, lines 8-13). As Smith relates to disposable tips for pipette devices, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide a stabilizing member at the open distal end of the nose to limit the possibility of cross contamination between samples, as taught by Smith.

Note, the pipettes are not considered part of the claimed invention.

In regards to claim 2, Smith further discloses the stabilizing member comprising a tubular sleeve projecting axially from the distal end of the nose.

In regards to claim 3, Smith further discloses the stabilizing member being rigid, and being detachably secured to the distal end of the nose, and having an inner diameter smaller than that of the entry opening of the resilient retainer.

In regards to claim 4, Smith further discloses the stabilizing member being snap fitted into the open distal end of the tubular nose.

In regards to claim 5, Pepicelli et al in view of Smith disclose the claimed invention except for the stabilizing member projecting axially from the distal end of the nose by a distance at least about 0.5 times the minimum diameter of the axial passageway in the resilient retainer. It would have been obvious to one having ordinary skill in the art at the time the invention was made to fabricate the stabilizing member projecting axially from the distal end of the nose by a distance at least about 0.5 times the minimum diameter of the axial passageway in the resilient retainer, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

### ***Response to Arguments***

Applicant's arguments filed 12/11/2006 have been fully considered but they are not persuasive.

In response to applicant's arguments, the recitation for connecting pipettes of various sizes has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

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In response to applicant's argument that the prior art does not disclose the resilient member with the pipettes extending through a distal end of the stabilizing member, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Further, the pipettes are not considered part of the claimed invention.

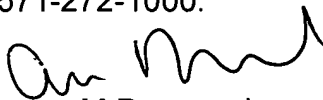
### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aaron M. Dunwoody whose telephone number is 571-272-7080. The examiner can normally be reached on 7:30 am - 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on 571-272-7087. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Aaron M Dunwoody  
Primary Examiner  
Art Unit 3679

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